

REMARKS:

Claims 1-28 are currently pending in the application.

Claims 1, 9, 17, and 25-28 stand rejected under 35 U.S.C. § 101.

Claims 1-28 stand rejected under 35 U.S.C. § 103(a) over U.S. Patent No. 6,823,495 to Vedula, et al. ("*Vedula*").

Applicant respectfully submits that all of Applicant's arguments and amendments are without *prejudice* or *disclaimer*. In addition, Applicant has merely discussed example distinctions from the cited prior art. Other distinctions may exist, and as such, Applicant reserves the right to discuss these additional distinctions in a future Response or on Appeal, if appropriate. Applicant further respectfully submits that by not responding to additional statements made by the Examiner, Applicant does not acquiesce to the Examiner's additional statements. The example distinctions discussed by Applicant are considered sufficient to overcome the Examiner's rejections. In addition, Applicant reserves the right to pursue broader claims in this Application or through a continuation patent application. No new matter has been added.

REJECTION UNDER 35 U.S.C. § 101:

Claims 1, 9, 17, and 25-28 stand rejected under 35 U.S.C. § 101 as allegedly being directed towards non-statutory subject matter. Applicant respectfully disagrees.

In particular, the Examiner states:

Claims 1, 9, 17, 25-28 are not directed to a process within the meaning of 101, since it is not a series of steps or acts being performed, but instead a program which when executed would cause a series of process steps or acts to occur. Claims 1, 9, 17, 25-28 are not directed to a machine within the meaning of 101, since it is not a part of a device or a combination of devices. Claims 1, 9, 17, 25-28 are not directed to a manufacture within the meaning of 101, since it is not an article produced from raw or prepared materials. Claims 1, 9, 17, 25-28 are not a composition of matter within the meaning of 101, since it is not a combination of two or more substances nor does it have any mass to be matter. Therefore, claims 1,

9, 17, 25-28 fail to fall within a statutory category of invention and is rejected as non-statutory on at least those grounds.

Claims 25-28 are directed to a software per se. Therefore they are not statutory.

(25 April 2008 Office Action, Page 2). Applicant respectfully disagrees. Nonetheless, Applicant has amended independent Claims 1 and 26 to further clarify that these claims each recite a global content directory server and a schema translation tool coupled with the global content directory server. In addition, Applicant respectfully submits that amended independent Claims 1, 9, 17, and 25-28 are directed to patentable subject matter and are clearly directed to patentable subject matter. Applicant further respectfully submits that these amendments are not considered narrowing or necessary for patentability. By making these amendments, Applicant does not indicate agreement with or acquiescence to the Examiner's position with respect to the rejections of these claims under 35 U.S.C. § 101, as set forth in the Office Action.

Independent Claims 17 and 28 Specifically Recites a Tangible Medium

In addition, as to independent Claims 17 and 28, Applicant respectfully directs the Examiner's attention to the Federal Circuit decision of *In Re Beauregard*, 53 F.3d 1583 (Fed. Cir. 1995), in which the Commissioner of the United States Patent and Trademark Office ("PTO") is quoted as stating, "Computer programs embodied in a tangible medium, such as floppy diskettes, **are patentable subject matter** under 35 U.S.C. § 101 and **must be examined** under 35 U.S.C. 102 and 103." *Id.* at 1584. (Emphasis added.) Independent Claims 17 and 28 recite Software for translating between schemas, the software embodied in a computer-readable medium, and thus is also statutory for at least this reason (in addition to its recitation of a useful, concrete and tangible result).

With respect to dependent Claims 2-8, 10-16, and 18-24, these claims depend from independent Claims 1, 9, and 17. As mentioned above, independent Claims 1, 9, and 17 are considered to be in full compliance with the requirements of 35 U.S.C. § 101. Thus, dependent Claims 2-8, 10-16, and 18-24 are considered to be in condition for allowance for at least the reason of depending from an allowable claim. Thus, Applicant respectfully requests that the rejection of Claims 1-28 under 35 U.S.C. § 101 be reconsidered and that Claims 1-28 be allowed.

In addition, Applicant respectfully requests that the Examiner call the undersigned, Steven J. Laureanti, at (480) 830-2700, if the Examiner has additional comments or suggestions to the 35 U.S.C. § 101 rejection of the subject Application or if the Examiner believes it would be easier to discuss the 35 U.S.C. § 101 rejection over the telephone.

REJECTION UNDER 35 U.S.C. § 103:

Claims 1-28 stand rejected under 35 U.S.C. § 103(a) over *Vedula*.

Applicant respectfully submits that the *amendments to independent Claims 1 and 26 have rendered moot the Examiner's rejection of these claims and the Examiner's arguments in support of the rejection of these claims*. Applicants further respectfully submit that amended independent Claims 1 and 26 in their current amended form contain unique and novel limitations that are not taught, suggested, or even hinted at in *Vedula*. Thus, Applicant respectfully traverses the Examiner's obvious rejection of Claims 1-28 under 35 U.S.C. § 103(a) over *Vedula*.

Vedula Fails to Teach, or Suggest Various Limitations Recited in Applicant's Claims

For example, with respect to independent Claim 1, this claim recites:

An *electronic commerce system for translating between one or more schemas*, the system comprising:

a *global content directory server* coupled to one or more seller databases, the global content directory server providing a plurality of buyers access to the one or more seller databases; and

a *schema translation tool* coupled to the global content directory server, the schema translation tool comprising:

a mapping module operable to:

receive information regarding a source schema and a target schema, the source and target schemas each comprising *a taxonomy comprising a hierarchy of classes into which products may be categorized, wherein the target schema comprises a different taxonomy than the taxonomy of the source schema*, at least the source schema further comprising *a product ontology* associated with one or more of the classes, each product ontology *comprising one or more product attributes*; and

associate one or more source classes of the source schema with one or more target classes of the target schema; and

an ontology generation module operable to generate a product ontology for each of the target classes based on the product ontologies of the associated source classes.

(Emphasis added). In addition, *Vedula* fails to disclose each and every limitation of independent Claims 9, 17, and 25-28.

Applicant respectfully submits that *Vedula* fails to disclose, teach, or suggest independent Claim 1 limitations regarding an “**electronic commerce system for translating between one or more schemas**” and in particular *Vedula* fails to disclose, teach, or suggest independent Claim 1 limitations regarding a “**global content directory server** coupled to one or more seller databases, the global content directory server providing a plurality of buyers access to the one or more seller databases”. In particular, the Examiner states:

Claim 1: Col. 1, line 24 refers to a global content directory in the form of the Internet. This directory is provided to buyers and sellers (col. 1, lines 27-28 “customers and trading partners”). FIG. 5 illustrates a graphical user interface which defines a **schema translation tool** which translates schema (4) to **schema (10)**. The tool is coupled to the global content directory (coupled to Internet----- col. 17, lines 44-46). Since mapping is accomplished between the schemas, the schema translation tool is a mapping module.

(25 April 2008 Office Action, Page 3). By contrast, the cited portion of *Vedula* on which the Examiner relies does not disclose a “**global content directory server** coupled to one or more seller databases, the global content directory server providing a plurality of buyers access to the one or more seller databases”, as recited in independent Claim 1 but is rather the “**BACKGROUND OF THE INVENTION**,” section of *Vedula*. (Column 1, lines 24-29). (Emphasis added). In fact, Applicant respectfully directs the Examiner’s attention to cited portions of *Vedula*, on which the Examiner relies:

The **Internet** is enabling businesses to develop new ways to facilitate efficient and automated interactions between their own internal line of business, productivity and knowledge management applications, the applications used by their customers and trading partners, and services provided by their commercial and corporate providers.

(Column 1, lines 24-29). (Emphasis added). Applicant respectfully submits that the examiner has mischaracterized the cited portion of *Vedula*. For example, the Examiner appears to equate

the “*global content directory server*” recited in independent Claim 1 with the “*Internet*” as disclosed in *Vedula*. (25 April 2008 Office Action, Page 3). However, *the Internet disclosed in Vedula does not include, involve, or even relate to the global content directory server*, as recited in independent Claim 1. (Column 1, Lines 24-29).

Applicant respectfully submits that the Examiner is merely relying on the “**BACKGROUND OF THE INVENTION**” section of *Vedula*, to equate the “*global content directory server*” recited in independent Claim 1 with the “*Internet*” disclosed in *Vedula*, however, the “**BACKGROUND OF THE INVENTION**” section of *Vedula* merely discloses that the *Internet enables businesses to interact* and that the *Internet is merely a way to facilitate this interaction*. In contrast, the “*global content directory server*” recited in independent Claim 1 is *coupled with a network, for example, the Internet, and provides a plurality of buyers access to one or more seller databases which are coupled with the global content directory server*. Thus, Applicant respectfully submits that the equations forming the foundation of the Examiner’s comparison between *Vedula* and independent Claim 1 cannot be made. Applicant further respectfully submits that these distinctions alone are sufficient to patentably distinguish independent Claim 1 from *Vedula*.

In addition, the Examiner further states:

FIG. 5 illustrates a graphical user interface which defines a schema translation tool which translates schema (4) to schema (10). The tool is coupled to the global content directory (coupled to Internet----col. 17, lines 44-46). Since mapping is accomplished between the schemas, the schema translation tool is a mapping module.

(25 April 2008 Office Action, Page 3). By contrast, the cited portion of *Vedula* on which the Examiner relies does not disclose a “*schema translation tool* coupled to the global content directory server” wherein the schema translation tool comprises a “*mapping module*” and a “*ontology generation module*”, as recited in independent Claim 1 but rather merely allows a *user to graphically connect nodes from a source object tree to a target object tree*. (Column 1, lines 24-29). In fact, Applicant respectfully directs the Examiner’s attention to Figure 5, on which the Examiner relies:

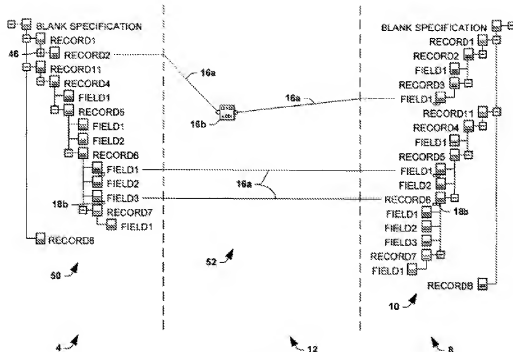


FIG. 5

In addition, Applicant respectfully directs the Examiner's attention to the cited portions of *Vedula*, which describe Figure 5, on which the Examiner relies:

Referring now to FIG. 5, another exemplary source object **graphical representation 50** is illustrated in region 4, wherein the branch for record node RECORD2 has been collapsed using the collapse indicia 46. In constructing or creating a **mapping 52** in the mapping screen region 12, the **user graphically associates or connects nodes from the source object tree 50 to the target object tree 10 using graphical mapping indicia 16**. These indicia may include link indicia 16a and/or function objects 16b. Such links 16a may be created by the user between 2 nodes, between a node and function object (e.g., function object 16b), and/or between 2 function objects, thus allowing cascading of the function objects 16b. Once created, such links 16a may be selected using a user interface selection device (e.g., mouse) and then moved, deleted, and/or modified whereby properties such as compiler directives associated therewith may be changed.

To construct a link 16a, a user selects or highlights a first object such as a node. For example, a user may select field node FIELD3 in the source object tree 50 using a user interface selection device (e.g., a mouse). The selection device may be moved to a second object such as record node RECORD6 of the target object tree 10. A link having thus been created, a link indicia 16a is displayed as a line in the mapping screen region 52 between the source object node FIELD3 and the target object node RECORD6. The connection of the nodes may be further indicated in the regions 4 and/or 8 via connection indicia 18b.

(Column 10, line 64 through column 11, line 23). (Emphasis added). Applicant respectfully submits that the Examiner has mischaracterized Figure 5 and the cited portion of *Vedula*. For example, Figure 5 of *Vedula* does not disclose a “graphical user interface which defines a schema translation tool which translates schema (4) to schema (10)”, as asserted by the Examiner (25 April 2008 Office Action, Page 3), but instead, Figure 5 is merely structured to show that a “user [can] *graphically associate[] or connect[] nodes from the source object tree 50 to the target object tree 10 using graphical mapping indicia 16.*” (Column 10, line 64 through column 11, line 23).

Therefore, the cited portions of *Vedula* on which the Examiner relies, clearly does not disclose a “*schema translation tool*” or even any type of *translation tool*, but rather discloses that a user can graphically connect nodes or put another way, the “*mapping indicia*” as disclosed in *Vedula* clearly does not equate to a “*schema translation tool*” of any kind. Applicant respectfully requests the Examiner to verify the references to *Vedula*, to ensure that some mistake has not been made.

The Office Action Acknowledges that *Vedula* Fails to Disclose Various Limitations Recited in Applicant’s Claims

Applicant respectfully submits that the Office Action acknowledges, and Applicant agrees, that *Vedula* fails to disclose various limitations recited in independent Claim 1. Specifically the Examiner acknowledges that *Vedula* fails to teach “that the individual records are not specifically referring to products”. (25 April 2008 Office Action, Page 4). However, the Examiner asserts that the acknowledged shortcomings in *Vedula* are “non-functional descriptive material”. Applicants respectfully traverse the Examiner’s non-functional descriptive material assertion.

Applicant respectfully submits that the Examiner has mischaracterized *Vedula*. For example, the Examiner asserts that “*Vedula* differs in that the individual records are not specifically referring to products, but are generic business documents records”. (25 April 2008 Office Action, Page 4). In addition, the Examiner cites *Vedula* Column 3, Line 10 as support for this assertion. However, Applicant respectfully directs the Examiner’s attention to the cited portion of *Vedula*:

(e.g., representing an XML business document by an XML schema)

(Column 3, Line 10). Applicant respectfully submits that *it is clear that nowhere in Column 3, Line 10 does Vedula provide for “generic business documents records”, as asserted by the Examiner.* (25 April 2008 Office Action, Page 4). In fact, Applicant finds no such teachings anywhere in *Vedula* and certainly not in the cited pages and paragraphs of *Vedula*, cited by the Examiner. Applicant respectfully requests the Examiner to verify the references to *Vedula*, to ensure that some mistake has not been made.

The Office Action Fails to Properly Establish a *Prima Facie* case of Obvious over *Vedula* According to the UPSTO Examination Guidelines

Applicant respectfully submits that the Office Action fails to properly establish a *prima facie* case of obviousness based on *Vedula*, and in particular, the Office Action fails to establish a *prima facie* case of obviousness based on the “Examination Guidelines for Determining Obviousness Under 35 U.S.C. 103 in View of the Supreme Court Decision in *KSR International Co. v. Teleflex Inc.*” (the “Guidelines”).

As reiterated by the Supreme Court in *KSR International Co. v. Teleflex Inc.* (*KSR*), the framework for the objective analysis for determining obviousness under 35 U.S.C. 103 is stated in *Graham v. John Deere Co.* (383 U.S. 1, 148 USPQ 459 (1966)). Obviousness is a question of law based on underlying factual inquiries. These factual inquiries enunciated by the Court are as follows:

- (1) Determining the scope and content of the prior art;
- (2) Ascertaining the differences between the claimed invention and the prior art; and
- (3) Resolving the level of ordinary skill in the pertinent art.

(Notice, 72 Fed. Reg. 57527 (Oct. 10, 2007)). Objective evidence relevant to the issue of obviousness must be evaluated by Office personnel. (383 U.S. 17–18, 148 USPQ 467 (1966)). As stated by the Supreme Court in *KSR*, “While the sequence of these questions might be reordered in any particular case, the [*Graham*] factors continue to define the inquiry that controls.” (*KSR*, 550 U.S. at ___, 82 USPQ2d at 1391).

However, it is important to note that the Guidelines require that Office personnel “**ensure that the written record includes findings of fact** concerning the state of the art and the teachings of the references applied. (Notice, 72 Fed. Reg. 57527 (Oct. 10, 2007)). In addition, the Guidelines remind Office personnel that the “**factual findings made by Office personnel are the necessary underpinnings to establish obviousness.**” (*id.*). Further, “**Office personnel must provide an explanation to support an obviousness rejection** under 35 U.S.C. 103. (*id.*). In fact, “35 U.S.C. 132 requires that Applicant be notified of the reasons for the rejection of the claim so that he or she can decide how best to proceed” and “clearly setting forth findings of fact and the rationale(s) to support a rejection in an Office action leads to the prompt resolution of issues pertinent to patentability.” (*id.*).

With respect to the subject application, the Office Action has not shown the **factual findings necessary to establish obviousness** or even **an explanation to support the obviousness rejection** based on *Vedula*. The Office Action merely states that “[f]orming the records to contain non-functional descriptive material, such as product information, would have been obvious to one of ordinary skill in the art”. (25 April 2008 Office Action, Page 4). Applicant respectfully disagrees and respectfully submits that the Examiner’s conclusory statement is not sufficient to establish the **factual findings necessary to establish obviousness** and is not a sufficient **explanation to support the obviousness rejection** based on *Vedula*.

The Guidelines further provide guidance to Office personnel in “determining the scope and content of the prior art” such as, for example, “Office personnel must first obtain a thorough understanding of the invention disclosed and claimed in the application.” (Notice, 72 Fed. Reg. 57527 (Oct. 10, 2007)). The scope of the claimed invention must be clearly determined by giving the claims the “broadest reasonable interpretation consistent with the specification.” (*See Phillips v. AWH Corp.*, 415 F.3d 1303, 1316, 75 USPQ2d 1321, 1329 (Fed. Cir. 2005) and MPEP § 2111.). In addition, the Guidelines state that any “**obviousness rejection should include**, either explicitly or implicitly in view of the prior art applied, **an indication of the level of ordinary skill.**” (Notice, 72 Fed. Reg. 57528 (Oct. 10, 2007)). With respect to the subject Application, the Office Action has not provided **an indication of the level of ordinary skill**.

The Guidelines still further provide that once the *Graham* factual inquiries are resolved, Office personnel must determine whether the claimed invention would have been obvious to one of ordinary skill in the art. (*Id.*). For example, the Guidelines state that ***Office personnel must explain why the difference(s) between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art. (Id.).*** In addition, the Guidelines state that the proper analysis is ***whether the claimed invention would have been obvious to one of ordinary skill in the art after consideration of all the facts. (Id. and See 35 U.S.C. 103(a)).***

With respect to the subject Application, the Office Action has not expressly resolved any of the *Graham* factual inquiries to determine whether Applicants invention would have been obvious to one of ordinary skill in the art. In addition, the Office Action fails to ***explain why the difference(s) Vedula and Applicant's claimed invention would have been obvious to one of ordinary skill in the art.*** Applicant respectfully requests clarification as to ***why the difference(s) between Vedula and Applicant's claimed invention would have been obvious to one of ordinary skill in the art.*** Applicant further respectfully submits that the Examiner is using the subject Application as a template to formulate reconstructive hindsight, which constitutes impermissible use of hindsight under 35 U.S.C. § 103(a).

The Guidelines yet further state that the “key to supporting ***any*** rejection under 35 U.S.C. 103 is the ***clear articulation of the reason(s) why the claimed invention would have been obvious.***” (Notice, 72 Fed. Reg. 57528 (Oct. 10, 2007)). In fact, the Supreme Court in *KSR* noted that ***“the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit.” (id.).*** The Court quoting *In re Kahn* (441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006)), stated that ***“[R]ejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.”*** (*KSR*, 550 U.S. at ___, 82 USPQ2d at 1396). The Guidelines provide the following seven rationales:

- (A) Combining prior art elements according to known methods to yield predictable results;
- (B) Simple substitution of one known element for another to obtain predictable results;
- (C) Use of known technique to improve similar devices (methods, or products) in the same way;

- (D) Applying a known technique to a known device (method, or product) ready for improvement to yield predictable results;
- (E) “Obvious to try”—choosing from a finite number of identified, predictable solutions, with a reasonable expectation of success;
- (F) Known work in one field of endeavor may prompt variations of it for use in either the same field or a different one based on design incentives or other market forces if the variations would have been predictable to one of ordinary skill in the art;
- (G) Some teaching, suggestion, or motivation in the prior art that would have led one of ordinary skill to modify the prior art reference or to combine prior art reference teachings to arrive at the claimed invention.

Applicants respectfully submit that the *Office Action fails to provide any articulation, let alone, clear articulation of the reasons why Applicants claimed invention would have been obvious*. For example, the *Examiner has not adequately supported the selection of Vedula to render obvious Applicant's claimed invention*. The Examiner's unsupported conclusory statements that “[f]orming the records to contain non-functional descriptive material, such as product information, would have been obvious to one of ordinary skill in the art”, *does not adequately provide clear articulation of the reasons why Applicants claimed invention would have been obvious*. (25 April 2008 Office Action, Page 4). In addition, the Examiner's unsupported conclusory statement *fails to meet any of the Guidelines rationales* to render obvious Applicant's claimed invention.

Thus, if the Examiner continues to maintain the obvious rejection based on *Vedula*, Applicant respectfully requests that the Examiner provide proper support for the obviousness rejection under 35 U.S.C. 103 as necessitated by the Guidelines, including an explicit analysis of the rationale relied upon by the Examiner.

Applicant's Claims are Patentable over the Proposed *Vedula*-Official-Notice Combination

Applicant respectfully submits that, for at least the reasons set forth above, independent Claim 1 is considered patentably distinguishable over *Vedula*. With respect to independent Claims 9, 17, and 25-28 each of these claims are also considered patentably distinguishable over *Vedula*, for at least the reasons discussed above in connection with independent Claim 1.

Dependent Claims 2-8, 10-16, and 18-24 depend from independent Claim 1, 9, and 17, respectively. As mentioned above, each of independent Claims 1, 9, and 17 are considered patentably distinguishable over *Vedula* and the Examiner's Official Notice. Thus, dependent Claims 2-8, 10-16, and 18-24 are considered to be in condition for allowance for at least the reason of depending from an allowable claim.

For at least the reasons set forth herein, Applicant respectfully submits that Claims 1-28 are not rendered obvious by the proposed combination of *Vedula* or the Examiner's Official Notice. Applicant further respectfully submits that Claims 1-28 are in condition for allowance. Thus, Applicant respectfully requests that the rejection of Claims 1- 28 under 35 U.S.C. § 103(a) be reconsidered and that Claims 1-28 be allowed.

CONCLUSION:

In view of the foregoing remarks, this application is considered to be in condition for allowance, and early reconsideration and a Notice of Allowance are earnestly solicited.

Although Applicant believes no fees are deemed to be necessary; the undersigned hereby authorizes the Director to charge any additional fees which may be required, or credit any overpayments, to **Deposit Account No. 500777**. If an extension of time is necessary for allowing this Response to be timely filed, this document is to be construed as also constituting a Petition for Extension of Time Under 37 C.F.R. § 1.136(a) to the extent necessary. Any fee required for such Petition for Extension of Time should be charged to **Deposit Account No. 500777**.

Please link this application to Customer No. 53184 so that its status may be checked via the PAIR System.

Respectfully submitted,

25 July 2008

Date

/Steven J. Laureanti/signed

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